

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Frederick L. Ross  
U.S. Patent Serial No.: 09/865,470  
Filing Date: May 24, 2001  
Examiner: Maria Teresa T. Thein  
Group No.: 3627  
Confirmation No. 2938  
Title: LOCAL RETURNS OF REMOTELY PURCHASED  
MERCHANDISE WITH RETURN CODE VALIDATION

**Mail Stop AF**  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the rejection of all claims in the Application.

**REMARKS**

In the prosecution of the present Application, the PTO's rejections and assertions contain clear errors of law. Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action (the "Final Office Action") to establish a *prima facie* rejection of the claims in the Application under 35 U.S.C. § 103. The Final Office Action rejected Independent Claims 1, 11, 21, and 29 under 35 U.S.C. § 103 as allegedly being obvious over U.S. Patent No. 6,085,175 issued to Junger ("*Junger*") and U.S. Patent No. 6,536,659 issued to Hauser et al. ("*Hauser*"). However, these rejections fail to meet the required *prima facie* standard for rejections for the reasons set forth below.

Independent Claim 1 is allowable because the proposed combination of *Junger* and *Hauser* fails to disclose, teach, or suggest "validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site." The Final Office Action explicitly relies on *Junger* for disclosure of the recited claim language. Specifically, the Final Office Action points to the disclosure of a "customer reference number" and states that the customer reference number "is entered to identify the return authorization." (Final Office Action, pages 3 and 14). Additionally, the Final Office Action points to column 8, lines 18-22 for disclosure of the creation of a return authorization number once the request is approved. (Final Office Action, pages 3 and 14). It is the Examiner's position that "[s]uch customer reference number with a return authorization number is the step of validating the return by matching the return validation code with a pre-authorization code." (Final Office Action, page 14).

In a Response to Final Office Action submitted on May 22, 2006 ("Response to Final Office Action"), Applicant contends that even when these two disjointed portions of *Junger* are read together in the manner proposed by the Examiner, the cited portions do not disclose "validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site," as recited in Claim 1. Specifically, Applicant demonstrates in the Final Office Action that the customer reference number is only vaguely disclosed in *Junger* and is neither of a "return validation code" or a "pre-authorization code," as recited in Applicant's Claim 1. Rather, *Junger* merely discloses that the customer reference number is used optionally to identify a bill of lading, file or invoice. (*Junger*, Column 7, lines 53-59). In fact, it is Applicant's contention that *Junger* does not disclose any operational use of the customer reference number at all. *Junger* merely discloses that the customer reference number may be entered "if desired." (*Junger*, Column

7, lines 53-59). Since *Junger* indicates that such a feature is optional, the customer reference number cannot be used to validate a return authorization or generate a return authorization number. Certainly, there is no indication in *Junger* that a return is validated by matching the customer reference number with the RMA number or anything else. This position is more fully described on pages 9-12 of the Response to Final Office Action.

As stated in the Final Office Action, Applicant's position is bolstered by Figure 4H of *Junger*, which illustrates the customer reference number included in only two of the four entries. In the Response to Final Office Action, Applicant directed the Examiner to Figure 4H, which indicates that batch number 15 has been approved. The customer reference number associated with batch number 15 is "kb12444" and the RA number is "915." Since these two numbers are different, they can not be matched to validate the return, and yet Figure 14H indicates that batch number 15 has been approved. Accordingly, it has been Applicant's contention and continues to be Applicant's contention that *Junger* (as relied upon by the Examiner) does not disclose, teach, or suggest Applicant's step of "validating the return by matching the return validation code with a pre-authorization code provided by the consumer to the local returns site," as recited in Claim 1.

In an Advisory Action mailed on June 7, 2006 ("Advisory Action"), the Examiner addressed Applicant's remarks by summarizing the return authorization process described in *Junger* and referring Applicant to previously cited portions of *Junger*. Additionally, the Examiner pointed to Figure 4F as illustrating a screen "shown before a return authorization (RA) is approved" that prompts an operator to enter a customer reference number. (Advisory Action, page 2). According to the Examiner, "[s]uch entering the name and phone number and a customer reference number for return authorization approval; the entered information is verified and re-validated; and the matching of an RA number with the approval are considered "validating the return by matching the return validation code with pre-authorization code obtained by the consumer." (Advisory Action, page 2). Applicant submits that this is a mischaracterization of the use of the customer reference number as disclosed in *Junger*.

Figure 4F merely illustrates a user interface screen for the inputting of information concerning a return authorization request. As discussed above, and as discussed in the Response to the Final Office Action, the customer reference number is entered "if desired." There is no disclosure in *Junger* that this customer reference number is matched with anything to result in the "validating [of] the return by matching the return validation code

with the pre-authorization code obtained by the consumer,” as recited in Applicant’s Claim 1. In fact, since the whole point of the method of *Junger*, as described by the Examiner, is to obtain return authorization (i.e., the RA Number illustrated in Figure 4H), Applicant contends that the information input into the user interface illustrated in Figure 4F cannot be said to include either a “return validation code” or a “pre-authorization code.”

For at least these reasons, Applicant submits that Independent Claim 1 and its dependents, Claims 2-7, are allowable. Independent Claims 8, 15, and 21 and their dependents, Claims 9-14 and 16-19, are allowable for analogous reasons.

Independent Claim 29 is allowable because the proposed combination of *Junger* and *Hauser* fails to disclose, teach or suggest a returns manager system that is operable to both “receive a first communication identifying at least an item of merchandise to be returned by the consumer in the future” and “send a second communication to the retailer identifying the item of merchandise to be returned by the consumer to provide the retailer with advance notification of the return.” The Final Office Action relies on *Junger* for disclosure of steps of receiving the first communication and sending the second communication but relies on *Hauser* for disclosure of “the item of merchandise being one to be returned by the consumer in the future and providing the retailer with advance notification of the return.” (Final Office Action, page 15).

In the Response submitted on May 22, 2006, Applicant contends that the rejection of Claim 29 is improper for two reasons. First, by separating the operational steps recited in Applicant’s claim language from the features recited within the operational steps, the piecemeal rejection of Claim 29 in the Final Office Action fails to consider the patentability of the particular combination of features and operations recited in Applicant’s claim language. Second, Applicant contends that *Hauser*, as relied upon by the Examiner, does not disclose, teach, or suggest “identifying the item of merchandise to be returned by the consumer to provide the retailer with advance notification of the return,” as recited in Claim 29. In the Final Office Action and in the Advisory Action, the Examiner points to Column 7, line 67 through Column 8, line 5 of *Hauser* as disclosing the pre-authorization of returns. (Final Office Action, page 16). Specifically, the Examiner maintains that the merchant electing to pre-authorize a customer to return any purchased merchandise is considered to be analogous to Applicant’s step of “identifying the item of merchandise to be returned by the consumer to provide the retailer with advance notification of the return.” Applicant has demonstrated in the Response to Final Office Action, however, that the very portion of

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*Hauser* relied upon by the Examiner indicates that the operation performed in Applicant's "identifying" step is unnecessary. Indeed, the very point of electing to pre-authorize customers to return merchandise is the elimination of any "need to obtain further authorization of the return." (*Hauser*, Column 7, line 66 through Column 8, line 3). Applicant's positions are more fully described on pages 13-15 of the Response to Final Office Action.

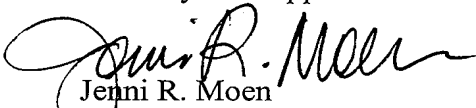
Furthermore, it has been Applicant's contention and continues to be Applicant's contention that *Hauser* actually teaches away from Applicant's claim language. *Hauser* discloses that "[a]fter the merchandise is received at the central returns facility, the scannable bar code is scanned so that the merchandise can be sorted by merchant, and the merchandise is then inspected to determine if the merchandise authorized for return has been received." (Abstract). Only then is "the appropriate merchant . . . advised" of the return. (Abstract). By disclosing that the merchant is not notified until the merchandise is received and scanned, *Hauser* actually teaches away from Applicant's claim language. Applicant's position is more fully described on pages 14-15 of the Response to Final Office Action.

For at least these reasons, Applicant submits that Independent Claim 29 and its dependents, Claims 30-39 are allowable.

### **CONCLUSION**

As the rejections of Claims 1-39 contain clear deficiencies, Applicant respectfully requests a finding of allowance of Claims 1-39. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorneys for Applicant

  
Jenni R. Moen  
Reg. No. 52,038  
(214) 953-6809

Date: July 3, 2006

**Correspondence Address:**

Customer No.

**05073**